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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/807,824

04/18/2001

Tomoyuki Asano

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6164

22852

7590

06/19/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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EXAMINER

CHEN, SHIN HON

ART UNIT

PAPER NUMBER

2131

MAIL DATE

DELIVERY MODE

06/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/807,824	ASANO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SHIN-HON CHEN	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15,17-37,39-45,47-69,71-73,75-90 and 138-157 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-15,17-37,39-45,47-69,71-73,75-90 and 138-157 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-7, 9-15, 17-37, 39-45, 47-69, 71-73, 75-90, and 138-157 have been examined.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/6/08 has been entered.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 9-15, 17-37, 39-45, 47-69, 71-73, 75-90, and 138-157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Traw et al. U.S. Pat. No. 5949877 (hereinafter Traw).

5. As per claim 1-7, 9-15, 17-37, 39-45, 47-69, 71-73, 73-95, 97, 99-114, and 138-161, Traw discloses a method for protecting digital content from copying and/or other misuse as it is transferred between devices, includes authenticating that both a content source and a content sink are compliant device by exchanging certificate identifying itself to each other (Traw: column 6

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lines 24-45; column 7 lines 55-60), when the certificates are verified to be valid, each device determines whether the devices are listed in CRL, if one of the device is listed in CRL, communication is halted (Traw: column 7 lines 58-65). In addition to authentication protocol, Traw discloses at least one certification revocation list version identifier is exchanged between the content source and the content sink, and if the received certificate revocation list version identifier is more recent than the certificate revocation list version identifier stored in the receiving device, then the certificate revocation list of the receiving device is updated (Traw: e.g. column 7 lines 62-65). Traw discloses that the compliant devices refer to electronic device capable of securely transferring contents (Traw: column 2 lines 51-53 and 61-64), Traw does not explicitly disclose the structure and arrangement of data stored within the compliant devices. However, it would have been an obvious matter of design choice to modify the data storing structure of Traw reference to contain security module and storage area distinctly from each other, since the applicant has not disclosed that having the security module and storage area arranged as distinct units solves any stated problem or is for any particular purpose and it appears that the data structure would perform equally well with the security module and storage area being arranged as a single entity with protection mechanism.

### ***Response to Arguments***

6. Applicant's arguments filed 3/6/08 have been fully considered but they are not persuasive.

Regarding applicant's remarks, applicant mainly argues that the compliant device disclosed by Traw reference cannot correspond to the claimed "portable data recording medium"

because Traw's compliant devices are not portable media. However, Traw discloses that the compliant devices refer to devices that are capable of securely transferring content that include, but not limited to, DVD recorders, set top boxes, and similar products (Traw: column 2 lines 51-65). Furthermore, the examiner has emphasized in present office action that the amendment to the claims is a matter of design choice and Traw discloses the same method of data protection as claimed by the applicant. Therefore, applicant's argument is traversed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIN-HON CHEN whose telephone number is (571)272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner  
Art Unit 2131

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